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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,946	08/07/2003	John V. Duncia	PH-7167	2410

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,946

Applicant(s)

DUNCIA ET AL.

Examiner

Celia Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,5,7,9,10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,5,7,9,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/4/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. A preliminary amendment was filed on Aug. 7, 2003. Claims 4, 6, 8, 11, 12 have been canceled. Claims 1, 5, 10, 15, 18, 19 have been amended. Claims 1-3, 5, 7, 9-10, 13-21 are pending.

2. Claims 1-3, 5, 7, 9-10, 13-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *allowed* claims 1-3, 5, 7, 9, 11-13, 15, 17, 19, 21, 25-28, 32-35, 37-39, 41-42 of copending Application No. 10/180,869 in view of US 6,492,400 and US 6,627,629.

Determination of the scope and content of the prior art (MPEP §2141.01)

The allowed claims of SN 10/180,869 are drawn to compounds wherein the E moiety is alkylene separated linkers with cyclic structure A.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the allowed claims and the instant claims is that instead of alkylene separated linker with cyclic structure A, the alkylene moiety is inserted with a carbonyl or sulfonyl group. Claims of US 6,492,400 and US 6,627,629 claimed that in similar compounds wherein the insertion of a carbonyl/sulfonyl moiety in E linker is an optional choice for such compounds.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art is deemed to be aware of all the pertinent art in the field. The above claims placed the E linker and its alternative choices in the possession of artisan in the field. The modification of a known compound with attributes of another proven compound is prima facie obvious.

3. Claims 1-3, 5, 7, 9-10, 13-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Broadly, the claims read on the compound of CA 135:137529 wherein the R5 moiety is heterocyclic thus, read on the claims yet the Ikegami et al. compounds are VLA-4 active. The specification lacks sufficient variations of operable examples of R5 being heterocyclic which would provide guidelines as to how to pick and choose compounds having the claimed utility

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while state of the art indicated compounds reading on the claims have patentably independent and distinct utility (see CA 135). Therefore, in view of the high degree of unpredictability in chemokine receptor activity and the totally unrelated activity in similar compounds as indicated by analogous compounds by Ikegami, the descriptive and enabling support for the "scope" as claimed is lacking.


In addition, claims 14-19 are considered reach-through claims without sufficient enabling support for the claimed scope in modulating chemokine receptor activity or CCR3 receptor activity or treating inflammatory diseases. While screening and assay indicated that compounds encompassed by the claims have efficacy in inhibiting one or more functions of mammalian chemokine receptor thus can inhibit inflammation which is a symptom occurring in many diseases, does not necessarily have efficacy in treating the "cause" of the disease i.e. the disease per se. (see Cecil medical textbook p.1937-1938).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Aug. 3, 2004


Celia Chang
Primary Examiner
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